

RECEIVED
CENTRAL FAX CENTER
NOV 15 2006

REMARKS

Claims 6-14 are added. Support for the new claims is provided by the originally-filed application at pages 10-19 and Figs. 2-10.

Claims 1-5 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. §112, second paragraph as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.

Claims 1-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lewis, et al. (U.S. Patent No. 5,275,836) in view of Waltson (<http://waltonfeed.com/self/rice.html>) in view of Ogawn (Abstract only JP92006330B).

Regarding the rejections based on §112, second paragraph for indefiniteness, the Examiner is respectfully reminded that MPEP §2173.02 (8th ed., rev. no. 3, vol. 2) states the essential inquiry pertaining to a §112, second paragraph requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) the content of the particular application disclosure;
- (B) the teachings of the prior art; and
- (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

S:\s8\046\m01

Page 7 of 13

Application Serial No. 10/699,160
Response to May 15, 2006 Office Action

IS8-045

(citations omitted) (emphasis added). The Examiner is further reminded that "A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers [and] [t]hey can define in the claims what they regard as their invention essentially in whatever terms they choose...."

MPEP §2173.01 (8th ed., rev. no. 3, vol. 2). In fact, the MPEP specifically states that if the Examiner merely wants the Applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. §112, second paragraph. MPEP §2173.02 (emphasis in MPEP).

Applicant directs the Examiner's attention to the fact that a claim must be analyzed pursuant to §112, second paragraph based upon "the claim interpretation that would be given by one possessing the ordinary level of skill." Inventors (Applicants) of this application can be considered as ones possessing the ordinary level of skill in the art, and such Inventors have approved the language of this application, including the claim language (see declaration filed pursuant to 37 CFR §1.56). Accordingly, the language as it stands is appropriate language and is given by ones possessing the ordinary level of skill, that is, the Inventors.

However, to the contrary, the Examiner states several phrases of the claims are indefinite without demonstrating that the *Examiner is one possessing the ordinary level of skill of the art*. The Examiner has not presented evidence that the Examiner is **one possessing the ordinary level of skill of the art**. Without this demonstration, the Examiner is simply making conclusory statements about definiteness *without evidence of the claim interpretation that*

Application Serial No. 10/699,160
Response to May 15, 2006 Office Action

168-045

would be given by one possessing the ordinary level of skill. To demonstrate such evidence, the Examiner must execute an affidavit stating the Examiner is one possessing the ordinary level of skill of the art and present same to Applicant, or have a person who is one possessing the ordinary level of skill of the art execute an affidavit and present same to Applicant. Pursuant to the authority above, "definiteness of claim language must be analyzed, not in a vacuum, but in light of ... **the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.**" Since the Examiner has not presented evidence as being a person possessing the ordinary level of skill of the art, the Examiner's statement of indefiniteness against language approved by the Inventors who are ones possessing the ordinary level of skill of the art does not meet the requirements for a rejection based on §112, second paragraph. Without an affidavit, the §112 rejections against the claims 1-5 are improper and must be withdrawn.

Regarding the rejection against claim 1 based on the combination of Lewis, Waltson and Ogawn, the Examiner states Lewis fails to teach "a primary alpha-type conversion step for converting at least surface layers of the rice grains obtained in the said immersing step to the alpha-structure type" as positively recited in claim 1. To provide as a teaching and motivation to modify the Lewis device, the Examiner states this limitation is "notoriously well known in the art." However, this is explicitly stated to be improper by the authority of the Federal Circuit Court.

The Examiner is respectfully reminded the Federal Circuit Court has rejected

Application Serial No. 10/699,160
Response to May 15, 2006 Office Action

IS8-049

the notion that "well known in the art" can support an obviousness rejection stating that "it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art." *Jones v Hardy*, 727, F2d 1524, 1527, 1528, 220 USPQ 1021, 1024 (Fed. Cir. 1984). For at least reason, the obviousness rejection is improper and must be withdrawn. Without a proper obviousness rejection, claim 1 is allowable.

In addition, the Examiner has failed to provide any objective evidence of the motivational rationale and alleged teaching of the positively recited limitation of claim 1 presented above, as is explicitly required by the Federal Circuit Court. The Federal Circuit Court states the factual inquiry whether to combine teachings and/or references must be thorough and searching. *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). It must be based on objective evidence of record. That is, motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art that would lead that Individual to combine the relevant teachings of the references. *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). In fact, the motivation identified in the present Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Lee Court stated that the Examiner's conclusory statements in the Lee case do not adequately address the issue of motivation to combine teachings. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority, same as the Examiner

Application Serial No. 10/699,160
Response to May 15, 2006 Office Action

188-045

presents in the present Office Action. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. Since in the instant case the record is entirely devoid of any evidence to support the alleged teachings apart from the bald conclusory statements of the Examiner, the obviousness rejection is improper pursuant to the authority of the Federal Circuit Court. Claim 1 is allowable.

Further regarding the rejection against claim 1, claim 1 recites a final polishing step for consummatively polishing the rice grains obtained in the said preliminary drying step. The Examiner states Lewis fails to teach a polishing and then attempts to suggest a connection to parboiling, which is allegedly taught by Lewis, to state it is "notoriously well know in the art" that parboiling allows the rice to be more easily polished. As stated above pursuant to authority of the Federal Circuit Court, "well know in the art" can not be relied upon for a proper obviousness rejection. Claim 1 is allowable.

Moreover, regarding the polishing step not taught by Lewis, the Examiner has not provided objective evidence of the teachings or that "parboiling allows the rice to be more easily polished," as is required by the authority of the Federal Circuit Court. Claim 1 is allowable.

In addition regarding the rejection against claim 1, claim 1 recites a **secondary** immersing step. The Examiner points to Lewis as allegedly teaching a single immersing step, and also points to Ogawn as allegedly teaching a single immersing step, but neither reference teaches a **secondary** immersing step, that is, two immersing steps as positively recited by claim 1. The Examiner is respectfully reminded that to establish

Application Serial No. 10/699,160
Response to May 15, 2006 Office Action

ISB-045

prima facie obviousness of a claimed invention, all of the claimed limitations must be taught or suggested by the prior art. MPEP §2143.03 (8th ed., rev. no. 3, vol. 2) *citing In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP §2143.03 *citing to In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The Examiner has failed to show teaching in the art to a **secondary** immersing step by only presenting two references that each allegedly teach a single immersing step. Since the Examiner has failed to show teachings in the art to all of the positively recited claimed limitations of claim 1, claim 1 is allowable.

Moreover, claim 1 recites to a secondary alpha-type conversion step and a final drying step, that is, two alpha-type conversion steps and two drying steps. The Examiner fails to show teachings to two alpha-type conversion steps nor two drying steps. Again, the Examiner has failed to show teachings in the art to all of the positively recited claimed limitations of claim 1. Providing two references that each teach a single step is not a teaching to two steps in the same method or processing. For these additional reasons, claim 1 is allowable.

Still further regarding the rejection against claim 1, claim 1 recites a separation-into-single-grains step. The Examiner provides absolutely no teachings from the cited references to this limitation as is required by the authority of the Federal Circuit Court. For at least this reason, claim 1 is allowable. Furthermore, the Examiner provides no objective evidence of a motivational rationale for teachings of this limitation, as is additionally required by the authority of the Federal Circuit Court. For at least this additional reason,

Application Serial No. 10/699,160
Response to May 15, 2006 Office Action

188-045

claim 1 is allowable.

Claims 2-5 depend from independent claim 1, and therefore, claims 2-5 are allowable for depending from an allowable independent claim.

Further applicant herewith submits a duplicate copy of the Form PTO-1449, Sheet 1, filed October 30, 2003. The Examiner initialed the foreign reference, but did not initial the U.S. reference. To the extent that the submitted reference listed on the Form PTO-1449 was not already considered, such examination and initialing are requested at this time, as well as a return of a copy of the initialed Form PTO-1449.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: 11-15-06

By: 

D. Brent Kenady
Reg. No. 40,045

Sheet 1 of 1

CCPY U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

LIST OF ART CITED BY APPLICANT
(Use several sheets if necessary)

ATTY. DOCKET NO. 158-045 SERIAL NO. Filed Herewith

APPLICANT Shigeharu Kasemoto et al.

FILING DATE Filed Herewith GROUP

U.S. PATENT DOCUMENTS

*Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date If Appropriate
AA	3,275,836	01/04/94	Lewis et al.			
AB						
AC						
AD						
AE						
AF						
AG						
AH						
AI						
AJ						
AK						

FOREIGN PATENT DOCUMENTS

	Document Number	Date	Country	Class	Subclass	Translation	
						Yes	No
AL	WQ 97/49300	12/31/97	PCT				
AM							
AN							
AO							
AP							

OTHER REFERENCES (including Author, Title, Date, Pertinent Pages, Etc.)

AR		
AS		
AT		

EXAMINER DATE CONSIDERED

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

EV979438988

COPY

Sheet 1 of 1

Form PTO-449		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTY. DOCKET NO. 333-463		SERIAL NO. Filed Herewith	
LIST OF ART CITED BY APPLICANT (Use several sheets if necessary)				APPLICANT Polychem, Kantocho et al.			
				FILING DATE Filed Herewith		GROUP	
U.S. PATENT DOCUMENTS							
*Examiner Initials		Document Number	Date	Name	Class	Section	Filing Date if Appropriate
	AA	3,373,836	01/09/94	Levi et al.			
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						
FOREIGN PATENT DOCUMENTS							
		Document Number	Date	Country	Class	Section	Translation
							Yes No
	AL	WO 92/07100	07/15/92	PCT			
	AM						
	AN						
	AO						
	AP						
OTHER REFERENCES (including Author, Title, Date, Periodic Page, Etc.)							
	AR						
	AS						
	AT						
EXAMINER				DATE CONSIDERED 4/18/06			
*EXAMINER: Initial if reference considered, whether or not citation is in conformity with MPEP 609; Draw line through citation if not in conformity and not considered. Include copy of this form with non communication to applicant.							

S:\5804\SJD1.upd

A27310301032N